

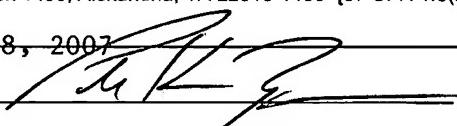


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) Skuba-P1-03
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Typed or printed name <u>Peter K. Trzyna</u>	First Named Inventor SKUBA, Jerome	Art Unit 3644
	Examiner PALO, Francis	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.		
This request is being filed with a notice of appeal.		
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.		
I am the		
<input type="checkbox"/> applicant/inventor.		Signature <u>Peter K. Trzyna</u>
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Typed or printed name <u>Peter K. Trzyna</u>
<input checked="" type="checkbox"/> attorney or agent of record. <u>32,601</u> Registration number _____		312-240-0824 Telephone number <u>312-240-0824</u>
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Date <u>June 8, 2007</u>
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.		



*Total of 3 forms are submitted.

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Ser. No. 10/730,325
Atty. Ref. Skuba-P1-03
Art Unit 3644

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Clear Errors or Omissions as to Claims 1-20: No cited art teaches or suggests a claim element.

Claims 1-20 have been rejected under 102(a) and/or 103(a) based on Kawamoto (referenced herein to its translation). Claims 1 and its dependents require: installing the piece, so that the roots can knit essentially unimpeded with the earth below the piece at the user's garden location... Claims 2 and its dependents require: installing the mats at the user's garden location so that the roots are able to knit essentially unimpeded with the earth below the mats ...

As to the Sec. 102 rejection, at page 6 of the office action of 03/08/07, the examiner concedes that "the manufactured multiple standardized units of Kawamoto are incapable of knitting with the earth below due to their containment means." There can be no anticipation because the cited art is incapable of meeting the claim limitation.

The examiner's conceding is well-taken. Not only would Kawamoto's containment means be incapable, Kawamoto is directed to "a garden on a rooftop and balcony of a building and inside a lot" (translation at page 3, line 32), such that some structure would impede roots from knitting essentially unimpeded with the earth below.... Kawamoto fails to disclose other claim limitations too, e.g., the Applicant's claims earth, but Kawamoto identifies "soil" as part of the problem to be solved by his invention (translation, page 4, line 9) and instead uses "artificial resin" (translation page 5, lines 11-12). See also, translation at page 5, line 22-24.

In the office action, at page 7, top paragraph, the examiner points to Kawamoto (translation paras. 0008 and 0032) as Kawamoto teaching soil, but this mischaracterizes Kawamoto, which instead teaches "artificial soil." The "artificial soil" would itself impede roots from knitting essentially unimpeded with the earth...

In sum, regarding the Sec. 102(a) rejection, there is no anticipation because the cited art fails to disclose the claimed limitation of: ... so that the roots can knit essentially unimpeded with

the earth below.... Cited art incapable of meeting a claim limitation cannot be anticipation, as conceded by the examiner. This omission of an essential element needed for a prima facie rejection is a clear error in the examiner's rejection.

As to the Sec. 103 rejection, prima facie obviousness has not been established because the rejection is premised on the Sec. 102 error discussed above: the reference fails to disclose an expressly claimed limitation; and the reference is incapable of meeting the above-mentioned limitation, as explained above.

Further, the modification of the cited reference to reach applicant's claim requirements is explicitly contradicted by Kawamoto's teachings of its containment means, "on a rooftop...", and "artificial soil" - all of which contradict or teach away from applicant's ... so that the roots can knit essentially unimpeded with the earth below....

In attempting to make a case of obviousness, the examiner proposes modifying the structure of Kawamoto that is incapable of meeting applicant's claim limitations where the cited art contains no motivation or suggestion to modify to reach applicant's claimed invention. This kind of modification is indicated *only* in applicant's claims, and thus the obviousness contention must be premised on a hindsight reconstruction.

The modification would destroy the intended function of the cited art because Kawamoto teaches that "soil" is part of the problem to be solved by his invention. It would destroy this explicit function of Kawamoto to instead have roots can knit essentially unimpeded with the earth below.... This is improper for a Sec. 103 rejection.

In sum, the Sec. 103(a) rejection builds on the error of the Sec. 102 rejection. A case of prima facie obviousness has not been set out because the reference fails to disclose expressly claimed limitation, the reference is incapable of meeting the above-mentioned limitation. This omission of one or more essential element needed for a prima facie rejection is a clear error in the examiner's rejection. There are additional clear errors in that the modification of the cited

reference to reach applicant's claim requirements is explicitly contradicted by Kawamoto's teachings, the cited art contains no motivation or suggestion to modify to reach applicant's claimed invention, and the modification is indicated only in applicant's claims and thus the obviousness contention must be premised on a hindsight reconstruction of applicant's claims.

2. Clear Errors or Omissions as to Claims 21: No cited art teaches or suggests a claim element.

Claim 21 has been rejected under 102(a) and/or 103(a) based on Kawamoto (referenced herein to its translation). Every step in the claim requires a corporate logo, e.g., transporting the corporate logo to a garden site, etc.

With regard to the Sec. 102 rejection, in the office action of 03/08/07, at page 9, the examiner points to the rejection of claims 1, 2, 16, and 17. None of these rejections mention transporting the corporate logo to a garden site, and thus the rejection is in error as incomplete. More to the point is that Kawamoto does not mention transporting the corporate logo to a garden site, and nothing in the cited art even mentions a corporate logo. Thus, the evidence is not sufficient for statutory anticipation.

The examiner argues (office action at page 4) that prior art "figures depict designs readable on 'logo's". What is readable by the examiner is not the same as statutory anticipation evidence, and notice can be taken of the plain and ordinary meaning of the term logo, e.g., Webster's Unabridged Dictionary, which defines a logo as "a graphic representation or symbol of a company name, trademark, abbreviation, etc., often uniquely designed for ready recognition." See also the original Fig. 6 in parent application US Patent No. 6,336,291, consistent with this definition. The examiner's argument is contradicted by the plain and ordinary meaning of the term logo and the parent's filing, and gives no weight to the preceding word, i.e., corporate logo.

The examiner also argues (page 3 of the office action) that applicant's specification states that "it is an additional object to provide a system for commercially producing a landscape

or garden design, such as a corporate logo" and thus, "that form of design is readable on a garden with an overall uniformity and a beautiful view as taught by Kawamoto" (office action at page 3, lines 3-12). However, applicant's "object" does not define a design as synonymous with corporate logo, and it is well established law that a broad disclosure of a genus (design, in Kawamoto) does not render any species (corporate logo) that falls within it obvious, let alone anticipated. Additionally, the examiner's interpretation is contradicted by the plain and ordinary meaning of the term logo and the application parent's original Fig. 6, and gives no weight to the preceding word in the claim, i.e., corporate logo.

In sum, regarding the Sec. 102(a) rejection, there is no anticipation because the cited art fails to disclose the claimed limitation of: transporting the corporate logo to a garden site, or even mention a corporate logo. This omission of one or more essential element needed for a *prima facie* rejection is a clear error in the examiner's rejection.

As to the Sec. 103 rejection, *prima facie* obviousness has not been established because the rejection is premised on the Sec. 102 error discussed above: the reference fails to disclose an expressly claimed limitation.

As stated above, the examiner's argument that disclosure of the genus (design, in Kawamoto) renders any species (corporate logo) obvious is an error of law. There is no teaching or suggestion in Kawamoto to lead the ordinary artisan to select the claimed specie (transporting the corporate logo to a garden site). The only mention of transporting the corporate logo to a garden site, etc, comes from the applicant.

Further, Kawamoto either contradicts or teaches away from applicant's claim requirements (translation para. 0053). A garden of "overall uniformity" contradicts or teaches away from forming a corporate logo. As to Kawamoto's "a garden on a rooftop and balcony of a building and inside a lot" (translation page 3, line 32), and the rejection has offered no reason as

to why one would be transporting the corporate logo to a "rooftop and balcony of a building and inside a lot" where it is not publicly viewable.

The cited art contains no motivation or suggestion to modify to reach applicant's claimed invention. This kind of modification is indicated only in applicant's claims, and thus the obviousness contention must be premised on a hindsight reconstruction of applicant's claims. This is improper for a Sec. 103 rejection.

In sum, the Sec. 103(a) rejection builds on the error of the Sec. 102 rejection. A case of *prima facie* obviousness has not been set out because the reference fails to disclose expressly claimed limitation. This omission of one or more essential element needed for a *prima facie* rejection is a clear error in the examiner's rejection, that element coming only from applicant. There are additional clear errors. Kawamoto either contradicts or teaches away from the claimed invention, the cited art (and rejection) contains no motivation or suggestion to modify to reach applicant's claimed invention, and the modification is indicated only in applicant's claims and thus the obviousness contention must be premised on a hindsight reconstruction of applicant's claims.

3. Clear Errors or Omissions as to Claims 16-17: No cited art teaches or suggests a claim element.

Paragraph Nos. 1 and 2 herein point out errors as regards claims 1 and 2, and 21. These errors combine as to claims 16-17, which use the corporate logo requirement somewhat differently from claim 21. The error in the rejection is omission of a *prima facie* showing of ...that the roots can knit essentially unimpeded with... in combination with ...corporate logo... in view of the comments set forth above.